

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays an OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
5236-000440/USI hereby certify that this correspondence is being filed electronically with
the United States Patent and Trademark OfficeApplication Number
10/674,667Filed
September 30, 2003First Named Inventor
Francis M. Creighton, IVOn September 2, 2009

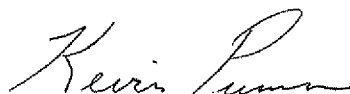
Signature

Art Unit
3737Examiner
John Fernando RamirezTyped or printed name Kevin PummApplicant requests review of the final rejection in the above-identified application. No amendments are being
filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is
enclosed. (Form PTO/SB/96)☒ attorney or agent of record.
Registration number 49,046.☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Kevin Pumm

Typed or printed name

314-726-7500

Telephone number

September 2, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple
forms if more than one signature is required, see below*.☒ *Total of 1 forms are submitted.

60560341.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/674,667
Filing Date: September 30, 2003
Applicant: Francis M. Creighton, IV
Group Art Unit: 3737
Examiner: John Fernando Ramirez
Title: Efficient magnet system for magnetically-assisted surgery
Attorney Docket: 5236-000440/US

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR REQUESTED PRE-APPEAL BRIEF REVIEW

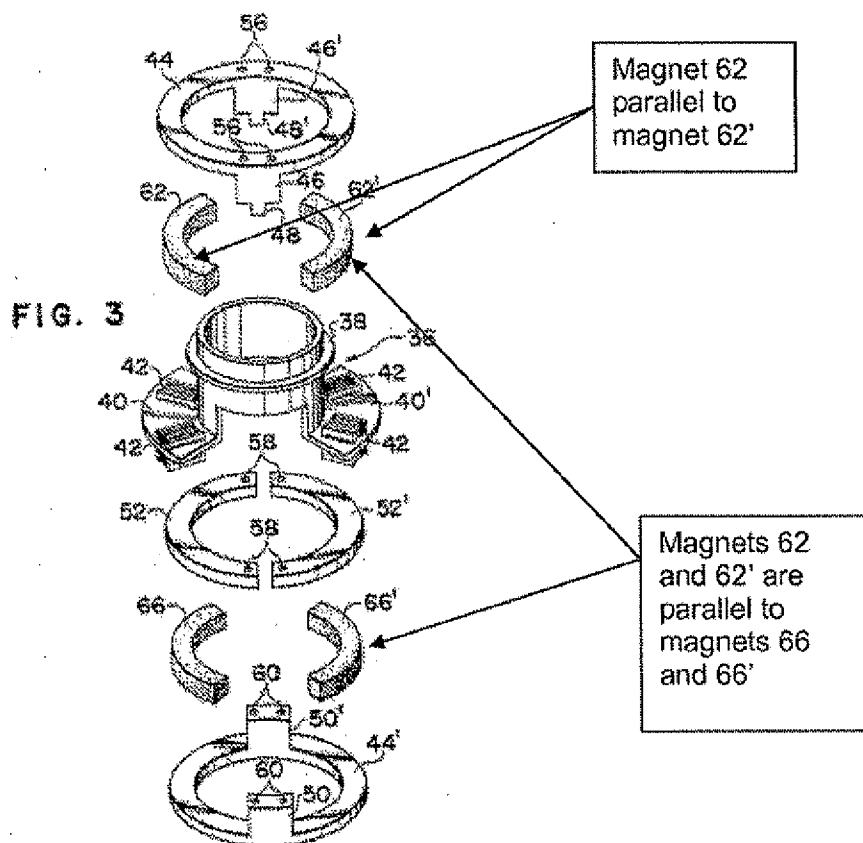
Applicant requests a pre-appeal brief review of the final rejection in the above-identified application for the reasons identified below.

1. REJECTION UNDER 35 U.S.C. § 102

Claims 39-41, 45-47 and 51-52 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Koike et al.* This rejection is respectfully traversed.

Applicant respectfully submits that the Office has not established a *prima facie* rejection of claims 39-41, 45-47 and 51-52 under §102(b) as being anticipated by *Koike*, because the rejection is based on misconstructions of terminology and errors in facts regarding the claimed compound magnet assembly.

The Final Office Action contends that Applicant argues the *Kioke* reference does not disclose segments arranged in a parallel manner. However, Applicant contends that the *Kioke* reference does not disclose the claimed compound magnet assembly, since *Kioke et al.* discloses separate magnets 62, 62' that are "isolated from each other," (and separate magnets 66, 66' that are "also isolated from each other,") so as to be "split" permanent magnets, as disclosed in col. 5, ll. 28-42 and shown in the figures below from the Final Office Action.



Thus, *Kioke* does not disclose magnet segments arranged to form a compound magnet assembly, as interpreted consistent with the specification. The Federal Circuit has maintained that a term in a cited reference cannot reasonably be construed to describe a claimed limitation in a manner that is inconsistent with that disclosed in the specification. (See *In re Buszard*, 504 F.3d 1364, 84 U.S.P.Q.2d 1749 (2007)).

The Office Action contends on page 4 that the features upon which Applicant relies (arranged in a parallel manner) are not recited in the claims, and that *Kioke* teaches a magnet assembly that contributes to a magnetic field at an operating point spaced from the magnet. However, the claim feature that Applicants are relying on, which is not taught in *Kioke*, is the structure of a compound magnet assembly shown in Applicant's Fig's 10 and 13 below that the Examiner included in the Final Office Action.

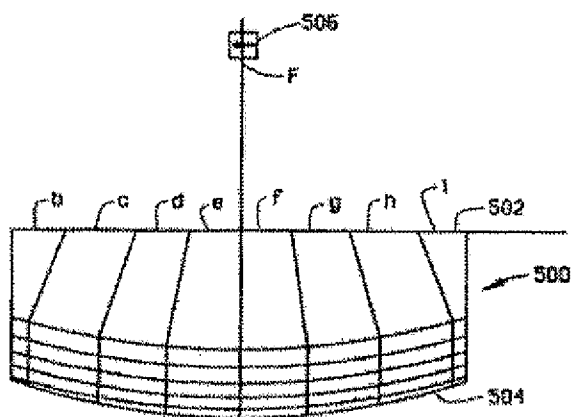


FIG. 10

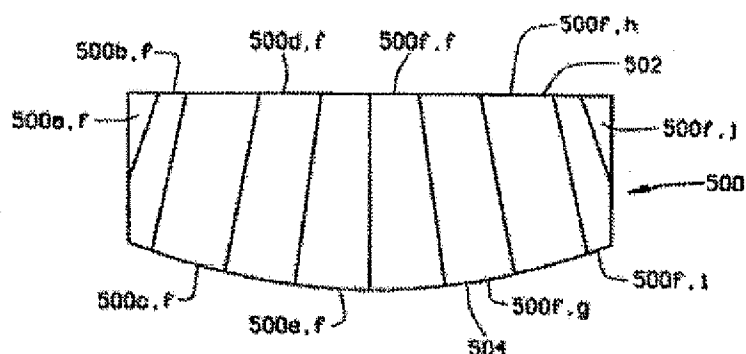


FIG. 13

Moreover, the Applicant also claims a compound magnet having segments that are each magnetized to provide the maximum magnetic field in a selected direction at a selected operating point (506) spaced from the front face of the compound magnet. *Kioke* has separate magnets (62, 62') that establish a magnetic field in diametrically opposed air gaps (64, 64') at a first location inside *Kioke's* stator, and separate magnets (66, 66') that establish a magnetic field in different diametrically opposed air gaps (68, 68') at a second location inside *Kioke's* stator. (*Kioke*, col. 5, ll. 33-45). *Kioke's* separate magnets that generate fields in different air gaps in the inside of a stator assembly cannot be reasonably interpreted consistent with the specification to read on a compound magnet assembly that generates a field at one operating point spaced from the magnet, as explained below.

In an earlier April 19, 2007 Office Action rejection that was reversed by the Board of Patent Appeals,¹ the Board ruled that a *Holcomb* reference disclosing (4) separate magnets providing magnetic fields in different locations did not anticipate a compound magnet assembly providing a magnetic field at an operating point spaced from a magnet.

Much like the Board's conclusion that *Holcomb's* (4) separate magnets could not define a compound magnet assembly providing a magnetic field at an operating point spaced from the magnet, *Kioke's* (4) separate magnets (62, 62', 66, 66') that establish fields in different gap locations can no more define the claimed compound magnet assembly that provides a magnetic field at an operating point spaced from a magnet. Furthermore, *Kioke's* fields in separate air gap locations on the inside of a stator assembly cannot be reasonably interpreted to disclose the claimed field at an operating point spaced from the magnet, as interpreted by one of ordinary skill in the art. This follows the reasoning in the Board's decision overturning the April 19, 2007 rejection, in which the Board concluded that one of ordinary skill in the art would not interpret the claimed compound magnet assembly that provides a field at an operating point spaced from the magnet as encompassing *Leupold's* cylindrical magnet 40 that produces a field within a cavity (17, 44).²

Much like the Board's determination that *Leupold's* field H within an internal magnet cavity (17, 44) was too constraining to be useful as an operating point, *Kioke's* (4) separated magnets (62, 62', 66, 66') that establish magnetic fields in air gaps inside of *Kioke's* cylindrical structure (*Kioke*, col. 2, ll. 29-55), cannot be reasonably interpreted as a field at one operating point spaced from the magnet.

¹ See *Ex parte Francis Creighton*, Appeal 2008-4386, (Aug. 15, 2008), p. 9-11; US Pat. Appl. 10/674,667.

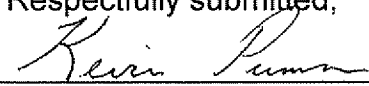
² *Id.* at 8-9.

Kioke's (4) separated magnets (62, 62', 66, 66') that establish fields within air gaps inside *Kioke's* assembly can no more provide a field at the operating point spaced from the center of the compound magnet assembly than *Leupold's* magnet could define a magnetic field spaced from *Leupold's* magnet. A person of ordinary skill in the art would not have reasonably construed *Kioke's* (4) separate magnets (62, 62', 66, 66') establishing fields in different air gaps inside of *Kioke's* assembly to read on the claimed field at an operating point spaced from the compound magnet assembly (as interpreted consistent with the specification). Thus, the Applicant submits that *Kioke's* separate magnets for generating a magnetic field within air gaps inside *Kioke's* assembly fails to disclose the claimed compound magnet assembly providing a field at the operating point spaced from the center of the compound magnet assembly (or a compound magnet assembly applying magnetic field in a selected direction at a selected operating point where the magnet assembly comprises a front face generally facing the operating point as in claim 45). Additionally, *Kioke's* separate magnets (62, 62', 66, 66') do not disclose the claimed feature in claims 41 and 45 of a surface of constant contribution to the magnetic field in the selected direction at the operating point. As such, the Applicants submit that claims 39, 41, 45, and claims 40 and 46-47 and 51-52 that ultimately depend from claims 39, 41, 45, are not obvious.

CONCLUSION

For all the foregoing reasons, the Applicant respectfully submits the Examiner has failed to establish a prima facie case of anticipation with respect to claims 11 and 21, and a prima facie case of obviousness with respect to rejected claims 16 and 26.

Dated: September 2, 2009
HARNESS, DICKEY & PIERCE, P.L.C.
7700 Bonhomme, Suite 400
St. Louis, MO 63105
(314) 726-7500
Serial No. [10/674,667]

Respectfully submitted,
By: 
Kevin Pumm
Reg. No. 49,046